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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|------------------------|--------------------------------|------------------------|
| 10/696,583 | 10/30/2003 | William J. Farrell JR. | 548.0001 | 7235 |
| 25534 | 7590 | 06/27/2007 | | |
| CAHN & SAMUELS LLP 2000 P STREET NW SUITE 200 WASHINGTON, DC 20036 | | | EXAMINER GILBERT, WILLIAM V | |
| | | | ART UNIT 3635 | PAPER NUMBER |
| | | | MAIL DATE 06/27/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/696,583 | Applicant(s) FARRELL ET AL. | |
| | Examiner William V. Gilbert | Art Unit 3635 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-10,12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This is a Final Office Action. Claims 7 and 11 have been cancelled. Claims 14-20 are withdrawn from consideration. Claims 1-6, 8-10, 12 and 13 are examined below.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the **clamp means, per Claim 4**, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of

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the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. **Claim 1** is objected to because of the following informalities: wording of the claim "positioned to define a gap a first gap between..." line 7. Examiner suggests delete "positioned to define a gap a first gap between", insert -- positioned to define a first gap between--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 claims the limitation "a second gap between said inner mesh member." No limitation is presented as to a second boundary for the gap (i.e. a second gap between said inner mesh member and _____.) Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6, 8, 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (U.S. Patent No. 4,611,450) in view of Sacks (U.S. Patent No. 6,820,387).

Claim 1: Chen discloses a construction panel (Fig. 2-3) having an outer and inner wire mesh member (223, located on both sides of the panel) that are screeds, and a middle member (Fig. 1: 10, 14, 16 and 18) disposed between the outer and inner mesh members and positioned to define a first gap (see Fig. 1, space between the middle member and mesh member) between the middle member and outer member and a second gap (opposing side) between the inner mesh member (as best understood by the Examiner.) Chen does not specifically disclose the screed having at least two outwardly projecting screed ridges extending a length of the outer wire mesh member. Sacks discloses a construction panel (Fig. 7: 36), having a screed member (Fig. 6) defining at least two outwardly projecting screed ridges (14) extending the length of an outer wire mesh member. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the screed member in Sacks with the panel in Chen

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because the purpose of the screed member in Sacks is designed to reduce cracking in stucco (Abstract, line 10) and would perform adequately with the panel in Chen.

Claim 2: the phrase "adapted to accept a dowel for securing said panel" is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 3: the middle member of Chen comprises a plurality of layers (Fig. 1: 10, 14, 16, 18) comprising wire trusses (211) and polystyrene foam (Abstract, line 11).

Claim 4: Chen in view of Sacks discloses the claimed invention including that the middle member (212) would be in a compressed state (which would occur when the stucco is applied), but the prior art of record does not disclose the compression is 2.5 inches. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to compress to this degree as a matter of design choice because Applicant did not state a criticality for the necessity of this limitation and the prior art of record is capable of being compressed in such a manner. The phrase, "secured by a clamp

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means...wire mesh members" lines 2 and 3 are method steps and only the final product, the panel, is considered.

Claim 5: while the ridges in Chen in view of Sacks are V-shaped (see Figure 1, below for clarification), and have a depth of about $\frac{1}{2}$ inch (Col. 7, lines 3 and 4), the specifics of the dimensions of the width of the panel. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have these dimensions because Applicant failed to state a criticality for the necessity of these limitations and the prior art of record is capable of conforming to the limitations.

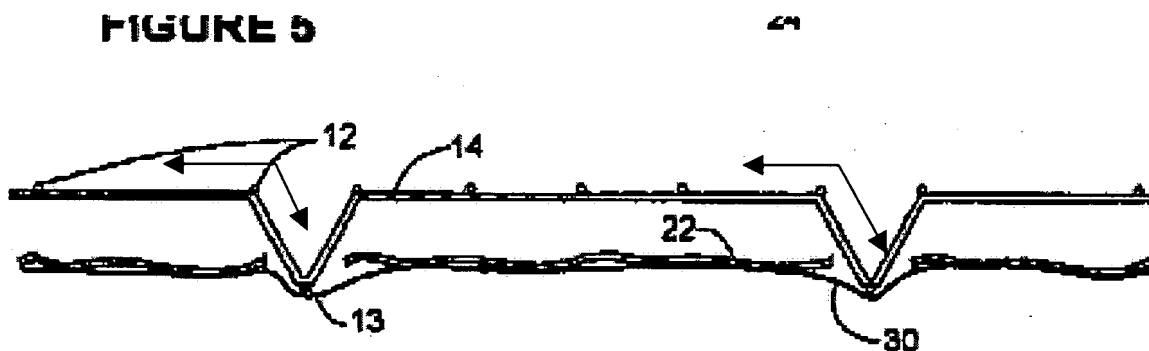


Figure 6 from Sacks

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Claim 6: Chen in view of Sacks discloses 2 parallel V-Shaped impressions (see above) defined in at least the outer wire mesh member.

Claim 8: Chen discloses means for securing the wire mesh member to the middle member (by through the truss member- (232)

Claim 10: Chen in view of Sacks discloses an outer layer (Chen: Claim 8), but not that the V-shaped impressions are used as a screed. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the V-shaped impressions (see above) as a screed in order to prevent the waste of stucco applied to the surface.

Claims 12 and 13: Chen in view of Sacks disclose the claimed invention except for the dimensions as claimed, though Sacks notes that any dimension may be created (Col. 7, lines 23-25). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have these limitations because Applicant failed to state a criticality for the necessity of these dimensions and the prior art of record is capable of meeting these limitations.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Sacks as applied to claim 8

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above, and further in view of Rockstead (U.S. Patent No. 4,104,842) and Salisbury (U.S. Patent No. 4,660,342).

Claim 9: Chen in view of Sacks discloses the claimed invention except for the use of hog rings and a Z-clip. Rockstead discloses a construction panel that uses hog rings (Col. 3, lines 41, 42) to attach to a wall system and Salisbury discloses the use of a Z-clip (Fig. 4: 49) in conjunction with a ring (50) to attach a panel to a wall. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the hog ring and Z-clip in conjunction with the panel in Chen in view of Sacks in order to securely attach the panel to another structural surface.

Response to Arguments

5. Applicant's arguments, see page 6, filed 13 April 2007, with respect to the Claim objections and 35 U.S.C. §112 rejections have been fully considered and are persuasive. The objection and rejection of the claims has been withdrawn.

Applicant's arguments with respect to claims 1-6, 8-10,12 and 13 have been considered but are moot in view of the new ground(s) of rejection as amended by the Applicant.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be

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reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WVG

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21 June 07

Robert Canfield
Primary Examiner

